

REMARKS

Claims 1, 8, 13, 20, 24, 25, 29, 32, 34-42, 45-51, 67-86, and 88-137 are pending. Claims 1, 8, 13, 20, 24, 25, 29, and 32 stand rejected under 35 USC 112, second paragraph as being indefinite for failing to particularly point out and distinctly elaim the subject matter which applicant regards as the invention. Claims 34-42, 45-51, 67-86, and 88-137 stand rejected under 35 USC 101 as being directed to non-statutory subject matter.

Reconsideration is requested. No new matter is added. The rejections are traversed. Claim 1, 51, 101, 116, and 130 are amended. Claims 1, 8, 13, 20, 24, 25, 29, 32, 34-42, 45-51, 67-86, and 88-137 remain in the case for consideration.

Claim Rejections – 35 USC 112

The Examiner indicated that claims 1, 8, 13, 20, 24, 25, 29 and 32 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Simultaneous and asynchronous, as used in “multiple simultaneous asynchronous accesses” in the claims, are not contradictory. Claim 1 recites a system for delivering digital content on demand in a multiple unit environment. The server is capable of supporting multiple simultaneous asynchronous accesses to the digital content.

For example, set-top boxes 120-2 and 120-3 are accessing movie 215 (shown by lines 247 and 250, respectively). Note that, although set-top boxes 120-2 and 120-3 are both accessing movie 215, they are currently at different points in movie 215, and have independent control over their viewing of movie 215. See Specification p. 6, ll. 15-19.

First, set-top boxes 120-2 and 120-3 are accessing the same digital content, the movie 215. Thus, there are multiple accesses to the digital content. Second, the set-top boxes 120-2

and 120-3 are accessing different points in digital content. Thus, the accesses are asynchronous. That is, the accesses are not related to one another, although the accesses can be. Third, the accesses are to the same digital content at the same time, although at different points. Thus the accesses are simultaneous. This is but one example of multiple simultaneous asynchronous accesses.

Regarding the “the default rate” on line 16 of claim 1, “the default rate” has been amended to be “a selected default rate.”

Regarding “the default rates and the custom rates” on lines 18-19, the Examiner has noted that lines 7-8 introduce the default and custom rates. As amended, “a default product rate” and “a default category rate” in claim 1 have been characterized as being part “of the default rates.” Thus, the default rates include the default category rate and the default product rate.

Regarding “the rate key” in line 19, that rate key is “the rate key of the user metadata.” As described in line 12, a user profile includes user metadata including at least one of the rate keys. Thus, “the rate key” in line 19 is the rate key from the user metadata in the user profile.

“Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.” MPEP 2173.02. After reading the application and the claims, one skilled in the art would understand the subject matter which the applicant regards as the invention.

The Examiner indicated that claims 1, 8, 13, 20, 24, 25, 29 and 32 would be allowable if rewritten or amended to overcome the rejections under 35 USC 112, second paragraph, set forth in this Office Action. As described above, claims 1, 8, 13, 20, 24, 25, 29 and 32 have been

amended to overcome the rejections under 35 USC 112. The applicant requests that the Examiner allow claims 1 and dependent claims 8, 13, 20, 24, 25, 29, and 32.

Claim Rejections – 35 USC 101

The Examiner indicated that claims 34-42, 45-51, 67-86 and 88-137 are rejected under 35 USC 101 because the claimed invention is directed to non-statutory matter.

Claims 34, 94, 109, and 124 fall within an enumerated statutory category

35 U.S.C. 101 covers “any new and useful *process*, machine, manufacture, or composition of matter” (emphasis added). Claim 34, for example, is a method of delivering digital content. Thus, claim 34, and similarly claims 94, 109, and 124 are processes, and hence, fall within an enumerated statutory category.

Claims 34, 94, 109, and 124 do not fall within a judicial exception

The Examiner appears to be arguing that because the method of claim 34, for example, can be implemented in a computer as described in claim 51, it is necessarily directed towards an abstract idea such as a mathematical algorithm.

“For purposes of an eligibility analysis, a physical transformation “is not an invariable requirement, but merely one example of how a mathematical algorithm [or law of nature] may bring about a useful application.”“ MPEP 2106 IV. C. 2. (2). In particular, in *AT&T Corp. v. Excel Communications Inc.*, 50 U.S.P.Q.2d 1447 (Fed. Cir. 1999), the court stated that:

The notion of “physical transformation” can be misunderstood. In the first place, it is not an invariable requirement, but merely one example of how a mathematical algorithm may bring about a useful application. As the Supreme Court itself noted, “when [a claimed invention] is performing a function which the patent laws were designed to protect (e.g., transforming or reducing an article to a different state or thing), then the claim satisfies the requirements of Section 101.” *Diehr*, 450 U.S. at 192 (emphasis added). The “e.g.” signal denotes an example, not an exclusive requirement.

This understanding of transformation is consistent with our earlier decision in *Arrhythmia*, 958 F.2d 1053, 22 USPQ2d 1033 (Fed. Cir. 1992).

Arrhythmia's process claims included various mathematical formulae to analyze electrocardiograph signals to determine a specified heart activity. *See id.* at 1059, 22 USPQ2d at 1037-38. The *Arrhythmia* court reasoned that the method claims qualified as statutory subject matter by noting that the steps transformed physical, electrical signals from one form into another form -- a number representing a signal related to the patient's heart activity, a non-abstract output. *See id.*, 22 USPQ2d at 1038. The finding that the claimed process "transformed" data from one "form" to another simply confirmed that Arrhythmia's method claims satisfied Section 101 because the mathematical algorithm included within the process was applied to produce a number which had specific meaning -- a useful, concrete, tangible result -- not a mathematical abstraction. *See id.* at 1060, 22 USPQ2d at 1039.

(*See Id.* at 1452; edits in original)

It is worth looking more closely at the claims in *Arrhythmia*. Claim 1 from *Arrhythmia*, which was found to be statutory subject matter, was as follows:

1. A method for analyzing electrocardiograph signals to determine the presence or absence of a predetermined level of high frequency energy in the late QRS signal, comprising the steps of:
converting a series of QRS signals to time segments, each segment having a digital value equivalent to the analog value of said signals at said time;
applying a portion of said time segments in reverse time order to high pass filter means;
determining an arithmetic value of the amplitude of the output of said filter; and
comparing said value with said predetermined level.

In *Arrhythmia*, the court held that the claim transformed the electrical signals, and that such a transformation was sufficient to satisfy the utility requirement of 35 U.S.C. § 101. Claim 1 in *Arrhythmia* does not actually recite an input of an electrocardiograph signal, and thus the claimed method does not require the actual input of such a signal. Nor does claim 1 of *Arrhythmia* require an output.

Claim 34 includes receiving a request for digital content from a unit in a multiple unit environment at a server, accessing the digital content from a memory on the server, and delivering the digital content to the unit in a multiple unit environment. Thus, the method transforms a request for the digital content into delivering the digital content itself. Just as in the transformation in *Arrhythmia*, this transformation results in a non-abstract result, namely the

requested digital content. Furthermore, beyond the scope of claim 1 in *Arrhythmia*, claim 34 includes an input of the request for the digital content, and an output of the delivery of the digital content. Thus, claim 34 does not fall within the judicial exception referred to by the Examiner. For similar reasons, claims 94, 109, and 124 do not fall within the judicial exception.

Claims 34, 94, 109, and 124 have a useful, tangible, and concrete result

Claim 34 is not merely an “abstract idea” such as delivering digital content: it is a practical application of that abstract idea. In determining whether a claim provides a practical application of a 35 U.S.C. 101 judicial exception that produces a useful, tangible, and concrete result, USPTO personnel should consider and weigh the following factors: a) useful result, b) tangible result, and c) concrete result. MPEP 2106 IV. C. 2. (2).

“For an invention to be “useful” it must satisfy the utility requirement of section 101.” MPEP 2106 IV. C. 2. (2) a. “If the applicant has asserted that the claimed invention is useful for any particular practical purpose (i.e., it has a ‘specific and substantial utility’) and the assertion would be considered credible by a person of ordinary skill in the art, do not impose a rejection based on lack of utility.” MPEP 2107 II. (B) (1). One example of a particular use is in a server storing digital content that is made available to units in a hospital, or a “cyber cafe,” or any other place where people gather and might want access to the digital content. See Specification, p. 3-4. Since claim 34 satisfies the utility requirement of 35 USC 101, it therefore has a useful result.

“The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a 35 U.S.C. 101 judicial exception, in that the process claim must set forth a practical application of that judicial exception to produce a real-world result.” MPEP 2106 IV. C. 2. (2) b. Claim 34 describes the delivery of digital content in response to a request for that digital content. An

example of a real-world result, as described above, is that people in a “cyber café” can request and receive digital content. Thus, claim 34 has a tangible result.

To produce a concrete result, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. “The opposite of ‘concrete’ is unrepeatable or unpredictable.” MPEP 2106 IV. C. 2. (2) c. In claim 34, a request for the digital content is received, the digital content is accessed, and the digital content is delivered. Nothing in claim 34 suggests unrepeatability or unpredictability. Thus, claim 34 has a concrete result.

As described above, claim 34 is in an enumerated statutory category. It is not within the judicial exception of an abstract idea. Even if claim 34 is interpreted as covering an abstract idea, it has a useful, concrete, and tangible result and is thus directed towards statutory subject matter. Claims 94, 109, and 124 are similarly directed towards statutory subject matter. As a result, claims 34-42, 45-51, 67-86 and 88-137 are allowable.

Claim differentiation requires that claims 34, 94, 109, and 124 cover more than a computer implemented process

Claim 34 is a method claim that the Examiner states covers a computer-implemented process. However, claim 51 is directed towards an article of code that can cause a computer to perform the method of claim 34, that is, can cause the computer to implement the processes of claim 34. “There is presumed to be a difference in meaning and scope when different words or phrases are used in separate claims. To the extent that the absence of such difference in meaning and scope would make a claim superfluous, the doctrine of claim differentiation states the presumption that the difference between claims is significant.” *Tandon Corp. v. United States Int’l Trade Comm’n*, 831 F.2d 1017, 1023, 4 USPQ2d 1283, 1288 (Fed. Cir. 1987).

To argue that claim 34 only covers a computer implemented-process makes the scope of claim 34 the same as the scope of claim 51, in conflict with the doctrine of claim differentiation. The doctrine of claim differentiation raises the presumption that there is a difference between claims that is significant. Thus, claim 34 is different from claim 51. As a result, claim 34 includes subject matter beyond a computer-implemented process covers and thus covers statutory subject matter even if a computer-implemented process might be non-statutory subject matter.

The operation of a general purpose computer can be statutory subject matter.

A suitably programmed general purpose computer is statutory subject matter. In particular, in *In re Alappat*, 31 U.S.P.Q.2d 1545 (Fed. Cir. 1994), the court stated that:

Alappat admits that claim 15 would read on a general purpose computer programmed to carry out the claimed invention, but argues that this alone also does not justify holding claim 15 unpatentable as directed to nonstatutory subject matter. We agree. We have held that such programming creates a new machine, because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software. In *re Freeman*, 573 F.2d 1237, 1247 n.11, 197 USPQ 464, 472 n.11 (CCPA 1978); In *re Noll*, 545 F.2d 141, 148, 191 USPQ 721, 726 (CCPA 1976); In *re Prater*, 415 F.2d at 1403 n.29, 162 USPQ at 549-50 n.29.

What makes a general purpose computer patentable is its operation, or the implementation of the new functions. Thus, the core of what is leading to patentability is the process the computer is performing. If a general purpose computer is implementing the method of claim 34, it would be patentable subject matter, for the same reasons claim 15 was patentable in *Alappat*. It is the method of claim 34 that is making the combination novel.

The Examiner appears to argue that because the method of claim 34 can be implemented in a computer, it becomes non-statutory subject matter. This distinction leads to an illogical conclusion. Under the Examiner's reasoning, a claim directed

towards a computer performing the method of claim 34 would be statutory subject matter, but the method of claim 34 alone would not be. This is not logical. The performance of the method in both cases leads to statutory subject matter, and so claim 34 should be patentable.

The *Alappat* court recognized this point, stating that:

Under the Board majority's reasoning, a programmed general purpose computer could never be viewed as patentable subject matter under Section 101. This reasoning is without basis in the law. The Supreme Court has never held that a programmed computer may never be entitled to patent protection. Indeed, the Benson court specifically stated that its decision therein did not preclude "a patent for any program servicing a computer." Benson, 409 U.S. at 71. Consequently, a computer operating pursuant to software may represent patentable subject matter, provided, of course, that the claimed subject matter meets all of the other requirements of Title 35.

This suggests that the operation of the computer pursuant to the software can be patentable subject matter under 35 USC 101. If a computer is implementing the method of claim 34, then it is operating according to claim 34. As a result, without more, claims 34, 94, 109, and 124 are directed towards statutory subject matter.

Programming a general purpose computer results in a useful, tangible, and concrete result

As described above, in *Alappat*, programming creates a new machine, because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions. In other words, the performance of the method creates the special purpose computer. This transformation from general to special purpose computer, in fact, the transformation from conventional computer into a new, patentable article, is a useful, tangible, and concrete result. Accordingly, claims 34, 94, 109, and 124 recite patentable subject matter.

Claims 51, 101, 116, and 130 are now embodied in a physical computer-readable medium

Claims 51, 101, 116, and 130 have been amended to recite an article of computer-readable code embodied in a physical computer-readable medium that when executed containing

a program to deliver digital content, the program being executable on a computer system, causes the computer system to implement the method of claims 34, 94, 109, and 124, respectively.

Thus, by executing the computer-readable code embodied in the physical computer-readable medium, the computer system realizes the functionality of the computer-readable code.

Accordingly, claims 51, 101, 116, and 130 are directed towards statutory subject matter.

For the foregoing reasons, reconsideration and allowance of claims 1, 8, 13, 20, 24, 25, 29, 32, 34-42, 45-51, 67-86 and 88-137 of the application as amended is solicited. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

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Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.

A handwritten signature in black ink, appearing to read 'Derek Meeker', is written over a horizontal line.

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